

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. STICE

Application No. 09/541,460

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on April 21, 2003. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

In section III of Appellant's Appeal Brief filed October 31, 2002 (Paper No. 9), the Appellant states that the status of claims is as follows:

1. Claims pending: 1-8
2. Claims canceled: Claim 3
3. Claims withdrawn from consideration but not canceled: 8-10

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4. Claims allowed: Claim 6
5. Claims rejected: Claims 1-5, 7 and 8
6. Claims on appeal: 1, 2, 4, 5, 7 and 8.

This statement of claims is defective because: 1) Claim 3 is not cancelled, as noted by the Examiner in his Examiner's Answer mailed January 2, 2003 (Paper No. 10), since the After Final Amendment that was filed May 28, 2002 (Paper No. 6) was denied entry; 2) Claim 8 has not been withdrawn from consideration; 3) Claims 9 and 10 do not exist in the application, and therefore, cannot be withdrawn from consideration; 4) Claim 6 is not allowed, but instead has been objected to for being dependent upon a rejected base claim. In his Examiner's Answer (Paper No. 10), the Examiner only identified the first issue as incorrect. All of these issues must be corrected prior to the appeal going forward. See MPEP §1208.

In section IV of the Appeal Brief, the Appellant states: "Applicant filed an Amendment After Final Rejection mailed May 13, 2001, which does not appear to have been acted upon by the Examiner." In response, the Examiner has indicated: "The appellant's statement of the status of amendments after final rejection contained in the brief is correct." In fact, both of these statements are incorrect. The Examiner responded to Appellant's amendment, by denying the entry of the amendment filed May 28, 2002, in the Advisory Action mailed by the Examiner on June 18, 2002 (Paper No. 7). If the Appellant has not received the Advisory Action, Appellant should request that the Examiner

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remail Paper No. 7. The required section "Status of Amendments" in the Appeal Brief and the Examiner's Answer must be corrected prior to the appeal going forward.

In section VI of the Appeal Brief, the Appellant sets forth the following issues:

Whether the drawings show the features specified in the claims, viz. the converter of line 2 of claim 5, the hysteresis in line 6 of claim 7, and the AD converter performing the method of claim 8.

Whether claims 7-8 are clear within the meaning of 35 U.S.C. 112, first paragraph, more particularly the relationship of overlapping offset bands to hysteresis and whether method claim 8 is sufficiently described in the specification for the understanding of one skilled in the art.

Whether applicant's amendments to independent claims 1, 4, 7 and 8 in the form shown in applicant's "Amendment After Final Rejection" render said claims definite within the meaning of 35 U.S.C. 112, second paragraph.

Whether claim 3 is patentable over Katsumata et al. ('189) within the meaning of 35 U.S.C. 103(a).

Claim 6 is not an issue in this appeal since currently being rewritten in independent form and filed in a continuation application.

Although the Examiner has indicated that the Appellant's statement of the issues in the brief is correct, that does not appear to be the case. The Examiner fails to point out that the objection to the drawing is a petitionable, not an appealable matter, and that the claims set forth in the "Amendment After Final Rejection" were denied entry, and thus cannot be an issue on appeal.

Lastly, the Examiner, in his Examiner's Answer, stated "[a] substantially correct copy of appealed claims 1-2, 4-5 and 7-8 appears on pages 8-10 of the Appendix to the appellant's brief. The minor error is as follows: it does not include claim 3." While the Examiner has failed to comply with MPEP §1208, by failing to provide a corrected copy of the missing claim, this is not the only error. Appellant's appendix incorporates all the changes in his Amendment After Final filed May 28, 2002 (Paper No. 6). Since this amendment was denied entry by the Examiner's Advisory Action mailed June 18, 2002, the Appellant may not incorporate these changes in his Appeal Brief. Appropriate correction is required.

In Section (9) of the Examiner's Answer, the Examiner lists 12 prior art references. However, the only reference applied is US Patent No. 4,736,189 to Katsumata et al., issued April 5, 1988. MPEP §1208 clearly states: "A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages (Emphasis added)." Appropriate correction of this defect is required prior to the appeal going forward.

Finally, there is no indication that an appeal conference was held in the application. MPEP §1208 states:

An appeal conference is mandatory in all cases in which an acceptable brief (MPEP § 1206) has been filed. However, if the examiner charged with the responsibility of preparing the examiner's answer reaches a conclusion that the appeal should not go forward and the supervisory patent examiner (SPE) approves, then no appeal conference is necessary.

The participants of the appeal conference should include (1) the examiner charged with preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal. During the appeal conference, consideration should be given to the possibility of dropping cumulative art rejections and eliminating technical rejections of doubtful value.

The examiner responsible for preparing the examiner's answer should weigh the arguments of the other examiners presented during the appeal conference. If it is determined that the rejection(s) should be maintained, the examiner responsible for preparing the examiner's answer will prepare the examiner's answer.

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held.

Upon receipt of the appeal case by the Board of Patent Appeals and Interferences (Board), the Board should review the application prior to assigning an appeal number to determine whether an appeal conference has been held. If the examiner's answer does not contain the appropriate indication that an appeal conference has been held (i.e., including the names of the conferees and identifying themselves as the conferees along with their initials), the Board should return the application directly to the appropriate Technology Center (TC) Director for corrective action. This return procedure by the Board should not be considered as a remand of the application. This procedure applies to all examiner's answers received by the Board on or after November 1, 2000.

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As can be seen from the last page of the Examiner's Answer, there are no conferee names listed. Appropriate correction is required.

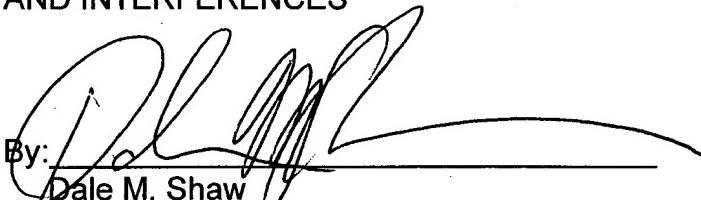
Due to the deficiencies in both the Appeal Brief and the Examiner's Answer, this application is not ready for a decision on appeal. Accordingly, the application is being returned to the Examiner for the following reasons:

- 1) To obtain an accurate statement of the Status of Claims. This can be accomplished by requiring Appellant to submit a new Appeal Brief correcting the Status of Claims, or by correcting the statement of the Status of Claims in a corrected Examiner's Answer.
- 2) To obtain an accurate statement of the Status of Amendments. This can be accomplished by requiring Appellant to submit a new Appeal Brief correcting the statement of the Status of Amendments, or by correcting the statement of the Status of Amendments in a corrected Examiner's Answer.
- 3) To obtain an accurate statement of the Issues on Appeal. This can be accomplished by requiring Appellant to submit a new Appeal Brief correcting the statement of the Issues on Appeal, or by correcting the statement of the Issues on Appeal in a corrected Examiner's Answer.
- 4) To obtain an accurate Appendix of Claims. This can be done by requiring Appellant to submit a new Appeal Brief correcting the Appendix of Claims, or by correcting the Appendix of Claims in a corrected Examiner's Answer.

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- 5) To obtain a corrected listing of the Prior Art of Record in the Examiner's Answer. This may be done in a corrected Examiner's Answer.
- 6) Conduct an Appeal Conference.

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